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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,774	02/06/2004	Gunther Durhammer	283-4 CIP	7901
23869 7590 04/04/2007 HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER EDEL, JOHN B	
			ART UNIT	PAPER NUMBER
			1731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/04/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/773,774	Applicant(s) DURHAMMER, GUNTHER	
	Examiner John B. Edel	Art Unit 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-3, 5-13, 15-20, 22-27, and 29-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over any of United States Patents 2,149,896 to McArdle et al. ("McArdle") 3,185,161 to Flore et al. ("Flore") and 3,911,932 to Houck Jr. et al. ("Houck") in view of United States Patent No. 2,091,572 to Swan ("Swan"). Hereinafter collective reference to McArdle, Flore, and Houck will be made using the shorthand ("COL") with the understanding that each is an independent basis of rejection.

As for claims 1-3, 6-13, 16-20, 22-23, 25-27, 29-30, and 32-36 COL teaches application of a layer of ethyl cellulose to a tobacco wrapper containing tobacco product [Houck abstract and col. 2 lines 20-30; Flore example 1; McArdle page 2 col. 1 lines 10-45]. Swan teaches what is not expressly taught by COL, namely the application of

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multiple coatings on paper with a gravure type process [figure 1]. At the time of the invention, it would have been obvious to a person having ordinary skill in the art of to use the coating method of Swan (coating drying then coating again) in any of the inventions of COL because Swan's invention produces uniform coatings with minimal defects [page 2 col. 1 lines 25-50]. COL and Swan are analogous because all relate to the coating of paper. Further, because COL recognizes the use of ethyl cellulose as a result effective variable for the control of moisture resistance [McArdle col. 1 lines 5-35; Flore col. 1 lines 20-35; Houck col. 3 lines 60-68] and the control of permeability of paper through measurement of Coresta units is notoriously well known in the tobacco manufacturing industry¹ it would be obvious to optimize the amount of coating and the number of coats of ethyl cellulose to within desired ranges.

As for claims 24 and 31, COL teaches the wrapper composed of one layer of paper [Flore col. 1 lines 15-25; Houck figure 2; McArdle col. 1 lines 1-10].

As for claims 5 and 15, Swan shows applying the multiple coats to the same side of the paper in figure 1.

Claims **4, 14, 21, and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Flore and Swan as applied to claims 2, 12, 18, and 25 above, and further in view of the additional disclosure in Flore of applying the protective material (ethyl acetate) to both sides of the paper [col. 1 lines 40-50].

¹ See United States Patents: US 4984589 A, US 4998543 A, US 5033484 A, US 5052412 A, US 5056537 A, US 5058608 A, US 5060674 A, etc.

Response to Arguments

Applicant's arguments filed January 16, 2007 with regard to Ishino teaching away from the present invention have been considered and are deemed persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of McArdle, Flore, and Houck as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Edel whose telephone number is (571) 272-4804. The examiner can normally be reached on 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBE


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